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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,098	07/28/2003	Jack R. Pfeffer	12,533	3517

7590 01/30/2006

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EXAMINER

SPERTY, ARDEN B

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/628,098

Applicant(s)

PFEFFER, JACK R.

Examiner

Arden B. Sperty

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2005.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☒ Claim(s) 23-25 is/are allowed.  
6) ☒ Claim(s) 1-22 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### **NON-FINAL OFFICE ACTION**

1. Applicant's Request for Continued Examination (RCE) has been received and entered. According to proper procedure, the amendment submitted After Final has not been entered. The claim set submitted with the RCE is the same as was previously examined for the Final Office Action.

#### ***Claim Objections***

2. Claim 15 is objected to for having an improper status identifier. "Presently presented" is not a proper status identifier. Since the claim is not presently amended, the status identifier should read "previously presented."
3. Claim 21 is objected to for having misplaced underscoring. The first letter of the claim is unnecessarily underlined, as is the word "material" in the last line of the claim. The claim is not presently amended, therefore nothing should be underscored.

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:
- The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
5. Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it

pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification is not enabled for a sheet having a thickness as low as the claimed endpoint of 0.25 inches. The lowest endpoint found in the specification is 0.75 inches.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 2, 7 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The structure implied by "wool-like" is unclear. In what way is the first layer like a wool?

8. Claims 14-18, 20 and 21 are indefinite because the claim language does not clearly state what applicant intends by performing the method step while the composite sheet is "being transported." Clarification of the implied step is required. Stating that the composite sheet is transported "on a conveyor," as is disclosed in the specification, would overcome the present rejection.

### ***Claim Interpretation***

9. It is interpreted that the second layer of claim 1 is a layer of binder. Therefore, the structure includes a first layer of homogenized glass fiber and binder, a second layer of binder, and a third layer of a woven glass fiber cloth. The binder referred to in part d) of claim 1 is the binder of the first layer and the second layer. No binder is necessarily implied in the third layer. This interpretation was first stated in the Non-Final office

action, 1/13/05, and was confirmed in the Final office action, 6/09/05, based on Applicant's election not to contest the interpretation.

***Claim Rejections - 35 USC § 102***

10. Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by US 4187275 to Bracalielly.

11. Drying and curing a sheet on a conveyor belt is notoriously well-known, as evidenced by the Bracalielly reference (column 4, lines 1-7), therefore the process limitations of claim 14 are met.

***Claim Rejections - 35 USC § 102/103***

12. Claims 1,2, 4-6, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6333280 to Hashimoto et al.

13. While Hashimoto is not concerned with the dimensions of the fibers of the decorative layer, which corresponds to the claimed first layer, the claimed dimensions are common and thus it is reasonable to presume they are inherently anticipated by the range of materials. The burden is shifted to applicant to show otherwise. In re Fitzgerald, 205 USPQ 495. In addition, the claimed fiber dimensions would obviously have been present when using the disclosed materials. In re Best, 195 USPQ 433.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 3, 7-10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6333280 to Hashimoto et al.

16. It would have been obvious to one of ordinary skill in the art to provide the optimal basis weight according to the ultimate intended use of the product, thus no patentable distinction is seen in the claimed values.

***Allowable Subject Matter***

17. Claims 15-22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The following is a statement of reasons for the indication of allowable subject matter: While drying and curing a sheet on a conveyor is notoriously well-known, the temperature and curing time are dependent upon the materials used, and thus are not taught or fairly suggested by the cited reference. Claims 23-25 are allowable as drafted. The claimed combination of elements is neither taught nor fairly suggested by the prior art.

***Response to Arguments***

18. To date, Applicant has not argued the stated prior art rejections. Applicant's repeated silence is taken as concession that the prior art teaches the claimed structures, as stated in the rejections of this office action.

19. In the RCE response, Applicant has not amended any claims in an attempt to overcome either the 35 USC 112 rejections, or the rejections in view of prior art. According to proper procedure, the amendment submitted After Final has not been entered. The claim set submitted with the RCE is the same as was previously examined for the Final Office Action.


20. Applicant's comments mistakenly indicate that amendments are made to the present claims. Applicant's comments also mistakenly indicate that the examiner indicated allowable subject matter, where in fact the examiner made no indication.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arden B. Sperty whose telephone number is (571)272-1543. The examiner can normally be reached on M-Th, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571)272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Arden B. Sperty  
Examiner  
Art Unit 1771

January 18, 2006



CHERYLA A. JUSKA  
PRIMARY EXAMINER